



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,511	01/20/2000	Yoshinori Aoki	12819-(JA999-099)	4532

7590

06/03/2005

Leopold Presser
SCULLY SCOTT MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY, NY 11530

EXAMINER

SCHLAIFER, JONATHAN D

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/488,511

Applicant(s)

AOKI ET AL.

Examiner

Jonathan D. Schlaifer

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

PP

DETAILED ACTION

1. This office action is in response to: RCE to Application 09/488,511, filed 3/8/2005.
Claims 1-2, 4-10, and 12-20 are pending on the application. No claims have been amended.
2. The rejections of claims 1-2, 4-10, and 12-20 under 35 U.S.C. 103(a) are withdrawn due to the fact that U.S. Patent 6,161,112 Cragun et al. (Cragun) was under common ownership with that of the present invention.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 16 and 20 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The medium should be a computer-readable medium in order to have a technological basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-2, 4-10 and 12-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Lowery et al. (USPN 5,894, 554—filing date 4/23/1996), hereinafter Lowery.**
5. **Regarding independent claim 1,** Lowery discloses a system for customizing a Web page by using at least one computer on which a browser for browsing a Web page runs (see Abstract, lines 1-2, the invention creates and manages custom Web pages), said system comprising: means for requesting an original Web page to be customized (Abstract discloses sending a generation request (line 5), which would include this limitation); means for embedding a customizing program in said requested original web page (in col. 2, lines 25-35, dynamic generation means are embedded); means for receiving said requested original Web page in which said program for customizing a page is embedded (col. 2, lines 25-35, dynamic generation passes page to generator); web browser means for displaying said received original Web page (Web page is displayed, which inherently requires a browser; means for having said program display a control panel for a customizing operation (col. 7, lines 45-60, tools like Visual Basic and Visual C++ or PowerBuilder allow customization); means for customizing said original Web page according to a customizing operation by a user using said control panel while said original Web page is retained for other users (Visual Basic, Visual C++ and PowerBuilder preserved backups of original web pages); and means for storing data pertaining to said customizing operation, wherein said web page is dynamically restored with said customizing data when subsequently accessed by said user (Visual Basic, Visual C++ and PowerBuilder fulfilled this limitation).

6. **Regarding dependent claim 2**, Lowery discloses a system wherein said means for requesting a Web page is a means for requesting a page from a Web server via a server or for requesting a locally stored Web page (see fig. 4, items 200-201).
7. **Regarding dependent claim 4**, Lowery discloses a system wherein said means for storing data on a customizing operation is a means for storing said data on a server (see fig. 4).
8. **Regarding dependent claim 5**, Lowery discloses a system wherein said system further comprises: means for having another computer request a Web page to be customized (see fig. 4; page servers vs. web server); means for having another computer receive said requested Web page in which a program for customizing a page is embedded (see fig. 4; page servers); means for having another computer display said received Web page by a browser (page is displayed, which inherently requires a browser); means for having said program display a control panel for a customizing operation(col. 7, lines 45-60, tools like Visual Basic and Visual C++ or PowerBuilder allow customization); and means for having said program, based on data of a customizing operation already performed on said Web page, reflect a customizing operation performed on said Web page on a browser(col. 7, lines 45-60, tools like Visual Basic and Visual C++ or PowerBuilder allow customization; this is reflected as in fig. 4 from web server to page server).
9. **Regarding dependent claim 6**, Lowery discloses a system wherein said system further comprises the means for further customizing a Web page according to a customizing operation by a user using said control panel from said another computer(see use of Web

client on Fig. 4 and col. 7, lines 45-60, tools like Visual Basic and Visual C++ or PowerBuilder).

10. **Regarding dependent claim 7**, Lowery discloses a system wherein said program is executable independent of any operating system or web browser (col. 7, lines 45-60, tools like Visual Basic and Visual C++ or PowerBuilder can be run on multiple OSes as there are multiple relevant tools and do not require a web browser).
11. **Regarding dependent claim 8**, Lowery discloses a system wherein said system comprises a means for immediately reflecting a result of a customizing operation on a browser (see Abstract, lines 12-18, the Web pages are dynamically generated).
12. **Regarding independent claim 9**, it is a method which is performed by the system of claim 1 and is rejected under similar rationale.
13. **Regarding dependent claim 10**, it is a method which is performed by the system of claim 2 and is rejected under similar rationale.
14. **Regarding dependent claim 12**, it is a method which is performed by the system of claim 4 and is rejected under similar rationale.
15. **Regarding dependent claim 14**, it is a method which is performed by the system of claim 5 and is rejected under similar rationale.
16. **Regarding dependent claim 15**, it is a method which is performed by the system of claim 6 and is rejected under similar rationale.
17. **Regarding dependent claim 16**, it is a medium that contains a method that is performed by the system of claim 7 and is rejected under similar rationale.

18. **Regarding dependent claim 17**, Lowery discloses a system wherein said customizing operation via said control panel includes one or more of adding an object, changing an attribute of an object or deleting an object (customizing must logically involve changing an object in some way and these are all the ways in which an object can change).
19. **Regarding dependent claim 18**, Lowery discloses a system wherein said customizing operation is performed without changing an existing web server providing said original Web page or said web browser (the customization operation occurs at the Web client, number 200, part of fig. 4, and hence does not affect the Web server directly).
20. **Regarding dependent claim 19**, it is a method that is performed by the system of claim 17 and is rejected under similar rationale.
21. **Regarding dependent claim 20**, it is a medium that contains a method that is performed by the system of claim 7 and is rejected under similar rationale.

Response to Amendment

22. Applicant's arguments with respect to claims 1-2, 4-10, and 12-20 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2178

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is (571) 272-4129. The examiner can normally be reached on 8:30-5:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS


STEPHEN HONG
SUPERVISORY PATENT EXAMINER